

REMARKS

Claims 1-9 and 12 are pending in this Application. Claims 10-11 and 13-15 have been canceled without prejudice. In the Office Action mailed October 6, 2005, the Examiner:

1. Rejected Claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over JP 60191074, an abstract assigned to Matsushita Electric Works Ltd. ("Matsushita"), US Patent No. 6,322,921 by Brothers et al. ("Brothers") and International Publication No. WO9721640 by Liskowitz et al. ("Liskowitz");
2. Rejected Claims 1-9 under 35 U.S.C. § 112, second paragraph, for failing to set forth subject matter regarded as the invention;
3. Rejected Claims 1-9 under 35 U.S.C. § 112, first paragraph, for claiming matter not considered commensurate in scope with Applicants' enabling disclosure; and
4. Objected to Claim 12 for depending on a rejected claim and would be allowable if combined with independent claim 1.

Claims Rejection - 35 U.S.C. § 103(a)

On page 2 of the Office Action, the Examiner rejected Claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Matsushita, Brothers and Liskowitz. Applicants respectfully disagree and point out that neither Matsushita, Brothers or Liskowitz alone or in combination make obvious Applicants' claimed invention, because none of the references provide a method of improving an hydraulic binder based coating formulation for coating a building product or disclose a slurry

dewatered through the building product. Referring to Matsushita, Applicants point out that the reference is merely an abstract that does not disclose a method of improving an hydraulic binder based coating formulation for coating a building product. Instead, Matsushita discloses only an inorganic hardened body produced from cement and two or more unidentified reactive fillers. Further, there is no evidence in the record of Matsushita of operability without undue experimentation. Nor is there in the record of Matsushita whether Matsushita's inorganic hardened body will solve the problem of providing an improved hydraulic binder, or whether Matsushita's inorganic hardened body is applied as a slurry to a building product or whether that said slurry is dewatered through the building product. All the above are unpredictable based on Matsushita and at least some degree of predictability is required for a showing of obviousness. Applicants submit that there is no reasonable showing or expectation of success in Matsushita that it can or does solve the problems identified above. Accordingly, there is no suggestion or motivation, either in Matsushita or to one of ordinary skill in the art, to modify Matsushita in order to provide Applicants claimed invention or to combine Matsushita with Brothers or Liskowitz.

Referring to Brothers, Applicants point out that the reference does not disclose a method of improving an hydraulic binder based coating formulation for coating a building product nor does it disclose a slurry dewatered through the building product. Rather, Brothers discloses a light weight high temperature well cement. The well cement includes a foam

stabilizer (Col. 3, ll. 66-67) and is foamed (Col. 3, ll. 52-53). In addition, Brothers specifically discloses that its purpose is to provide an "improved less expensive well cement compositions useful in cementing high temperature wells containing carbon dioxide" (Col. 1, ll. 53-60). There is no evidence on the record of Brothers that it solves the problem of providing an improved hydraulic binder for coating a building product, that Brothers' is applied as a slurry to a building product or that said slurry is dewatered through the building product. Accordingly, all the above are unpredictable based on Brothers and at least some degree of predictability is required for a showing of obviousness. As such, there is no suggestion or motivation, either in Brothers or to one of ordinary skill in the art, to modify Brothers in order to provide Applicants claimed invention or to combine Brothers with Matsushita or Liskowitz.

Referring to Liskowitz, Applicants point out that Liskowitz does not disclose a method of improving an hydraulic binder based coating formulation for coating a building product nor does it disclose a slurry dewatered through the building product. Rather, Liskowitz discloses cement fly ash for use in concrete or mortar that has a diameter of less than 11 micrometer with a median particle diameter of less than about 4.0 micrometer (Claim 1). In addition, the Liskowitz reference specifically discloses that it solves several unmet needs including "a need in the art to utilize all of the fly ash produced in coal-dust fired boilers . . . a further need to process fly ash efficiently to provide about 100% yield of

useful product. . . [and] yet a further need in the art for the utilization of fly ash generated during coal combustion" (last lines of Background of the Invention). There is no evidence on the record of Liskowitz that it solves the problem of providing an improved hydraulic binder for coating a building product, that Liskowitz is applied as a slurry to a building product or that said slurry is dewatered through the building product. Accordingly, all the above are unpredictable based on Liskowitz and at least some degree of predictability is required for a showing of obviousness. As such, there is no suggestion or motivation, either in Liskowitz or to one of ordinary skill in the art, to modify Liskowitz in order to provide Applicants claimed invention or to combine Liskowitz with Matsushita or Brothers.

With regard to Claim 1, Applicants also respectfully submit amended Claim 1, amended to include a method of improving an hydraulic binder based coating formulation for coating a building product having a first and second surface comprising: adding to said hydraulic binder a dewatering agent, said dewatering agent comprising fly ash, wherein the fly ash further comprises at least a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients and at least a second portion having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients, such that after application of a slurry of said formulation to said first surface of said building product, said slurry is dewatered

through the building product to said second surface of said building product." [Emphasis added to show amended text.]

Support for amended Claim 1 may be found throughout the specification, see, for example, paragraphs [0010]-[0015], [0032]-[0036], and [0054]. For example, support for fly ash comprising a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients may be found in paragraphs [0032], [0033] and [0035], as summarized below.

[0032] . . . the fly ash comprises two components.

[0033] The second 'smaller' fly ash size zone which preferably has about a 10 micron maximum size . . .

[0035] The second fly ash component preferably provides about 5 to 30 wt % of the formulation based on total dry ingredients . . .

In addition, support for fly ash comprising a second portion having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients may be found in paragraphs [0032] and [0034], as summarized below.

[0032] . . . the fly ash comprises two components. A first 'larger' size particles of fly ash with preferably about a 100 micron maximum size.

[0034] . . . first fly ash comprises about 10 to 60 wt % of the formulation based on total dry ingredients . . .

Support for application of a slurry of said formulation to said first surface of said building product can be found in the Examples. Support for a slurry dewatered through the building product to the second surface may be found, for example, in the Examples and in paragraph [0054], as summarized below.

[0054] . . . The building product to be coated exhibits a certain degree of porosity causing the slurry to dewater and form a uniform deposited cementitious layer. Time for dewatering can vary quite dramatically but normally occurs between about 10 and 90 seconds, depending on the porosity of the material to be coated, its water content and thickness and viscosity of the slurry formulation. A vacuum may be used to reduce the slurry dewatering time if required. This is particularly useful when tailoring the coating process to the speed of a building product forming process, eg between about 40 to 45 seconds on a Hatschek production line.

No new matter has been introduced with amended Claim 1. Entry and allowance of amended Claims 1 is respectfully requested. Applicants further submit that neither Matsushita, Brothers or Liskowitz alone or in combination make obvious Applicants' claimed invention, because none of the references cited teach or suggest each and every element of amended Claim 1 nor the claimed invention as a whole. Firstly, none of the references, alone or in combination teach or suggest a method of improving an hydraulic binder based coating formulation for coating a building product, as discussed previously. In addition, none of the references, alone or in combination, teach or suggest a slurry dewatered through the building product, as discussed previously. Further, none of the references cited disclose or suggest, alone or in combination, fly ash comprising a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients and a second portion having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients. The Examiner is respectfully requested to point to such a

teaching if it exists. Accordingly, none of the cited references teach or describe as a whole, expressly or inherently, alone or in combination, each and every element as set forth in amended Claim 1 nor do they have elements arranged as required by amended Claim 1. Moreover, because there is no evidence on the record in any of the cited references that any of them solve the problem of providing an improved hydraulic binder for coating a building product, or of applying a slurry of said formulation to the building product, or that said slurry is dewatered through the building product teaches, or of fly ash comprising a first portion having a maximum particle diameter of around 10 microns in the amount of about 5 to 30 wt.% of the formulation based on the total dry ingredients and a second portion having a maximum particle diameter of around 100 microns in the amount of 10 to 60 wt.% of the formulation based on the total dry ingredients, all the above are unpredictable in each of the cited references cited, whether viewed alone and in combination. However, for a showing of obviousness, and at least some degree of predictability is required. Applicant further points out that there is no suggestion or motivation, either disclosed in each of the cited reference or to one of ordinary skill in the art, to modify any of the cited references of Matsushita, Brothers or Liskowitz in order to provide amended Claim 1 or to combine such reference teachings. For this reason, there is no reasonable expectation of any success. Finally, Applicant reiterate that, none of the references, Matsushita, Brothers or Liskowitz, when combined teach or suggest all the claim limitations of amended Claim 1. In view of all factual information, amended Claim 1 "as a whole" and all

claims depending therefrom would not have been obvious over Matsushita, Brothers or Liskowitz.

Claims Rejection - 35 U.S.C. § 112, second paragraph

On page 2 of the Office Action, the Examiner rejected Claims 1-9 under 35 U.S.C. § 112, second paragraph, for failing to set forth subject matter that Applicants regard as the invention. For the reasons set forth above and as supported by the specification, Applicants submit that amended Claim 1 includes subject matter particularly pointed out and distinctly claimed.

Claims Rejection - 35 U.S.C. § 112, first paragraph

On page 3 of the Office Action, the Examiner rejected Claims 1-9 under 35 U.S.C. § 112, first paragraph, stating that the claimed invention is not commensurate in scope with Applicants' enabling disclosure. For the reasons set forth above and as supported by the specification, Applicants submit that amended Claim 1 is commensurate in scope with Applicants' enabling disclosure.

Claims Rejection - 35 U.S.C. § 112, first paragraph

On page 4 of the Office Action, the Examiner objected to Claim 12 because it was stated to depend upon a rejected claim and further stated it would be allowable if combined with independent claim 1. Applicants respectfully submit new Claims 18 and 19 that include a coarse fly ash portion having a particle size diameter of greater than 100 microns. New Claims 18 and 19 are in accordance with the Examiner's statement: "It is the examiner's position that should Applicants accept these

Attorney Docket No. 129843.1143
Customer No. 60148

AMENDMENT AND RESPONSE
APPLICATION NO. 10/090,561

14

changes in their next response, this application will be in condition for allowance. Applicants also submit amended Claims 4, 8 and 12, amended as to matters of form, and new Claims 16 and 17 believed to further define the invention as claimed by the Applicants. Support for Claims 16 and 17 can be found throughout the specification, at, for example, paragraph [0054], [0055], and the Examples. No new matter has been introduced with new Claims 16-19. Entry and allowance of such claims are respectfully requested.

A Power of Attorney and Correspondence Address Indication Form signed by a person having apparent authority to sign on behalf of the Assignee as an officer of the Assignee (in accordance with 37 C.F.R. §§ 3.71 and 3.73) is also provided with this Amendment to appoint all practitioners associated with Customer Number 60148, including the agent signing this Amendment, full power to prosecute this Application for patent, to make alterations and amendments thereto and to transact all business connected herewith with the United States Patent and Trademark Office. Submitted with the Power of Attorney and Correspondence Address Indication Form is a Statement under 37 C.F.R. § 3.73(b). Accordingly, this Amendment is heretofore signed by an attorney or agent of record acting in a representative capacity as provided by 37 C.F.R. § 1.34.

CONCLUSION

Applicants respectfully submit that the Application is in condition for allowance, and Applicants earnestly seek such allowance of Claims 1-9 and 12, new Claims 16-19. Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 129843.1051. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

Attorney Docket No. 129843.1143
Customer No. 60148

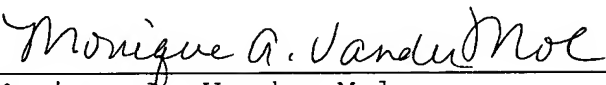
AMENDMENT AND RESPONSE
APPLICATION NO. 10/090,561

16

This is intended to be a complete response to the Office
Action mailed October 6, 2005.

Please direct all correspondence to the practitioner listed
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Respectfully submitted,



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